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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/932,213 | 08/17/2001 | William Webb | 25216-0863 | 5012 |

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EXAMINER

CHANG, KENT WU

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2673

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DATE MAILED: 03/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,213

Applicant(s)

WEBB ET AL.

Examiner

Kent Chang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 14 recites moving the second segment in a single direction between the contracted position and the extended position. However, it appears that the second segment is moving in two directions (up and down) between the contracted position and the extended position.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 3, 4, 6, 7, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Granberg (US2003/011225A1).

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Consider claim 1. Granberg discloses a handheld computer a first segment (the touch panel section 17); a second segment (keypad section 11) moveably coupled to the first segment to move between a contracted position and an extended position; a display assembly provided by the first segment; a first input mechanism (19) provided by the second segment (11); wherein the first input mechanism overlays a portion of the display assembly when the second segment is in the contracted position, and wherein the first input mechanism is positioned away from the display assembly so that the portion of the display assembly is accessible to contact by a user when the second segment is in the extended position.

Consider claim 3. The display assembly in the device of Granberg includes an immediate character recognition section (the basis function of the touch panel) configured to immediately recognize and display assembly a character entry, and wherein the portion of the display assembly that is overlaid by the first input mechanism includes the immediate character recognition section.

Consider claim 4. The exterior surface of the second segment includes a front panel, a plurality of input mechanisms including the first input mechanism being actuatable by the front panel, and wherein the front panel overlays the portion of the display assembly when the second segment is in the contracted position.

Consider claim 6. The device of Granberg further comprises a plurality of input mechanisms including the first input mechanism, and wherein at least one

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of the plurality of input mechanisms is a button that can be pressed to cause an input to be entered onto the handheld computer.

Consider claim 7. The device of Granberg further comprises a plurality of input mechanisms including the first input mechanism, and wherein at least one of the plurality of input mechanisms (the touch panel) is actuatable by detecting surface contact.

Consider claim 14. The second segment in the device of Granberg is moveable up and down between the contracted position and the extended position.

Claims 19-22 and 27-29 are similar to claims 1, 3, 4, 6, 7, 14, thus note the rejections above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2, 5, 23, are rejected under 35 U.S.C. 103(a) as being unpatentable over Granberg (US2003/0112225A1).

Consider claims 2 and 23. Granberg discloses a handheld computer a first segment (the touch panel section 17); a second segment (keypad section 11) moveably coupled to the first segment to move between a contracted position

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and an extended position; a display assembly provided by the first segment; a first input mechanism (19) provided by the second segment (11); wherein the first input mechanism overlays a portion of the display assembly when the second segment is in the contracted position, and wherein the first input mechanism is positioned away from the display assembly so that the portion of the display assembly is accessible to contact by a user when the second segment is in the extended position. It would have been obvious for one of ordinary skill in the art at the time of the invention to include a first section having a cross-section comprising a digitizer pad and a screen, and a second section comprising the digitizer pad without the screen, and wherein the portion of the display assembly that is overlaid by the first input mechanism includes the second section. One of ordinary skill in the art would have realized that using a smaller display and a touch panel to replace display section (17) in the device of Granberg would have enabled to reduce the cost of the device, provide a display with better quality by reducing the size of the display and eliminating the digitizer overlaying the display.

Consider claim 5. It would have been obvious for one of ordinary skill in the art at the time of the invention to include a multi-directional member (cursor controller such as a trackball) so as to control the movement of the cursor.

7. Claims 8-13, 15-18, 24-16, and 30-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Granberg (US2003/011225A1) in view of Gray (US Patent No. 5,440,629).

Granberg discloses a handheld computer a first segment (the touch panel section 17); a second segment (keypad section 11) moveably coupled to the first segment to move between a contracted position and an extended position; a display assembly provided by the first segment; a first input mechanism (19) provided by the second segment (11); wherein the first input mechanism overlays a portion of the display assembly when the second segment is in the contracted position, and wherein the first input mechanism is positioned away from the display assembly so that the portion of the display assembly is accessible to contact by a user when the second segment is in the extended position. Granberg is silent in having a collapsible middle portion.

Gray teaches a handheld device having a collapsible middle portion with a midframe and cooperating guide tracks and guide elements. The first segment in the device of Gray includes a first rail and a second rail, and wherein the second segment includes a first connecting member and a second connecting member, the first connecting member being engaged to the first rail, the second connecting member being engaged to the second rail, the first connecting member and the second connecting member each being slideable along a length of the respective first rail and second rail to enable the second segment to move between the contracted position and the extended position (see figure 10, 11 and column 8 lines 44-59). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to include a collapsible middle portion with a frame and cooperating guide tracks and guide elements as taught by Gray in the device of Granberg so as to provide additional input

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function when the second segment is in the extended position but have smaller size when the second segment is in the contracted position.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maeda (US Patent No.5,450,619), Meins et al (US Patent No. 56,587,700), Shindo (US Patent No. 5,661,641), Fischer et al (US Patent No. 5,821,881), Duarte (US Patent No. 6,636,419), and England (US Patent No. 6,483,445).

CONTACT INFORMATION

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kent Chang whose telephone number is 703-305-4824. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bipin Shalwala, can be reached at 703-305-4938.

Any response to this action should be mailed to:

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Washington, D.C. 20231

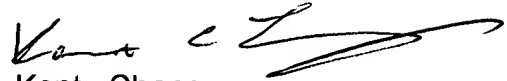
or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

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Hand-delivered responses should be brought to Crystal Park II, 2121
Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or
proceeding should be directed to the Technology Center 2600 Customer
Service Office whose telephone number is 305-9700.



Kent Chang
Primary Examiner
Art Unit 2673

Kc
3/8/04